103(a) as being unpatentable over Verrier in view of Agulnick, and further in view of U.S. Patent No. 6,249,606 to Kiraly et al. ("Kiraly"). Applicants respectfully traverse all rejections.

Independent Claim 1

Independent claim 1 is directed to a method for detecting an in-air gesture. The method of claim 1 comprises, *inter alia*, recording positional information of a digitizing pen with respect to a surface of a digitizing writing surface within a moving buffer when the digitizing pen is determined to not be in contact with the digitizing writing surface and when the digitizing pen is determined to be in motion with respect to the digitizing writing surface, the moving buffer recording a predetermined amount of positional information spanning a predetermined amount of time.

Verrier is cited in the Office Action as teaching a "method for detecting an in-air gesture comprising step of...recording positional information...within a moving buffer (76)." Applicants respectfully disagree. Element 76, which the Office Action attempts to compare with the claimed moving buffer, is disclosed as being a storage device that merely stores a personal identification number, password or other security information. (Verrier, col. 7, lns. 67-68; col. 9, lns. 18-21). Thus, *element 76 in Verrier does not record positional information*, as does the moving buffer of claim 1.

In an attempt to remedy the deficiencies of Verrier, the Office Action refers to Agulnick. However, as correctly indicated in the Office Action mailed November 18, 2003, Agulnick does not disclose the claimed moving buffer. Thus, the proposed combination of Agulnick with Verrier also fails to teach or suggest the claimed moving buffer.

Moreover, at best the proposed combination of Verrier and Agulnick would result in the system of Agulnick (which discloses the use of gestural commands drawn in contact with a screen) with the proximity sensing mechanism of Verrier, to ensure that only gestures drawn in contact with the screen (as opposed to when there is a small separation) will be recognized. Indeed, the whole point of Verrier is to solve the problem of spurious in-air motions and ensure that positive contact with the screen is accurately determined (Verrier, col. 2, lns. 40-43, 51-58, and 65-68).

In addition, the Office Action does not provide a motivation from the prior art to combine Verrier and Agulnick as proposed. The Office Action states that it would have been obvious to incorporate determining whether positional information recorded in the moving buffer (again, Agulnick does not have the claimed moving buffer) corresponds to a predetermined in-air gesture, in order to provide a pen-based computing device in which the behaviors are easily recognized by a computer in a convenient way for users to control or invoke certain functions. Even if it were assumed for the sake of argument that Verrier or Agulnick indicate that there was a need for such a convenience, there is nothing in the prior art suggesting that using in-air gestures would have provided a convenient way for users to control or invoke certain functions. Even more so, there is nothing in the prior art that would have motivated one to use in-air gestures, not just in *any* manner, but in the *particular* manner recited in claim 1. In fact, Verrier and Agulnick's steadfast focus on improving the determination of contact between the stylus and the display *teaches away* from using in-air gestures. Verrier considers a motion of the stylus in the air to be spurious as opposed to a motion of the stylus in contact with the display. (Verrier, col. 2, lns. 51-58). As previously discussed, Agulnick does not even

sense in-air gestures. Thus, both references alone, and any combination of the two, would ignore any gestures made in-air.

In fact, the only source from which the Office Action could have drawn the conclusion that in-air gestures are convenient is from Applicants' own disclosure. However, it is improper to piece together the claimed invention using Applicants' own disclosure as a roadmap. According to the U.S. Court of Appeals for the Federal Circuit, "[i]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teaching of the prior art." *In re Fritch*, 972 F.2d 1260, 1266 (quoting *In re Fine*, 837 F.2d 1071, 1075, USPQ 2d 1596, 1600 (Fed. Cir. 1988). In essence, the motivation stated in the Office Action for combining Verrier and Agulnick is simply improper hindsight and a conclusory determination of obviousness. Hence, the rejection does not meet its burden of establishing a *prima facia* case of obviousness.

Accordingly, Applicants submit that claim 1 is allowable.

Independent Claim 20

Independent claim 20 is also allowable for at least similar reasons as those set forth above with regard to claim 1, and further in view of the differing recitations therein.

Independent Claim 39

Independent claim 39 is directed to a method for receiving a command input in a computer system. The method of claim 39 comprises, *inter alia*, detecting a motion of a stylus with respect to an electronic writing surface, the stylus not physically contacting the electronic writing surface during the motion, and determining, responsive to the motion stopping, whether the motion of the stylus corresponds to a first motion from a plurality of predefined motions.

Neither Verrier nor Agulnick, either alone or in combination, teach or suggest determining anything *responsive to stylus motion stopping*. Although Agulnick discloses that the beginning and end of a gesture may be determined by sensing *the proximity* of a stylus from a display (Agulnick, Abstract), this simply means that some action is taken responsive to the proximity of a stylus from a display, *not* responsive to the motion of the stylus stopping as in the invention of claim 39. Verrier fails to teach or suggest this feature missing from Agulnick, as does the proposed combination of Verrier in view of Agulnick.

Moreover, as discussed above with regard to claim 1, the proposed combination is improper due to the lack of a valid motivation in the prior art being asserted.

Accordingly, Applicants submit that claim 39 is allowable.

Independent Claim 41

Independent claim 42 is also allowable for at least similar reasons as those set forth above with regard to claim 39, and further in view of the differing recitation therein.

Dependent Claims

Claims 2-19, which depend from claim 1, claims 21-38, which depend from claim 20, and claim 40, which depends from claim 39, are also allowable over Agulnick and Verrier for at least those reasons set forth above with regard to their respective independent claims, and further in view of the additional features recited therein. Moreover, the remaining asserted references (Greanias, Altman, and Kiraly) do not make up for the deficiencies of Verrier and Agulnick as previously discussed.